

Union Calendar No. 120

105TH CONGRESS  
1ST Session

**H. R. 1661**

[Report No. 105-194]

**A BILL**

To implement the provisions of the Trademark Law Treaty.

JULY 21, 1997

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

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## IN THE HOUSE OF REPRESENTATIVES

MAY 20, 1997

Mr. COBLE introduced the following bill; which was referred to the Committee on the Judiciary

JULY 21, 1997

Reported with an amendment, committed to the Committee of the Whole House on the State of the Union, and ordered to be printed

[Strike out all after the enacting clause and insert the part printed in italic]

[For text of introduced bill, see copy of bill as introduced on May 20, 1997]

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## A BILL

To implement the provisions of the Trademark Law Treaty.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       *This Act may be cited as the “Trademark Law Treaty*  
5       *Implementation Act”.*

1 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

2 *For purposes of this Act, the Act entitled “An Act to*  
 3 *provide for the registration and protection of trademarks*  
 4 *used in commerce, to carry out the provisions of certain*  
 5 *international conventions, and for other purposes”, ap-*  
 6 *proved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be re-*  
 7 *ferred to as the “Trademark Act of 1946”.*

8 **SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.**

9 *(a) APPLICATION FOR USE OF TRADEMARK.—Section*  
 10 *1(a) of the Trademark Act of 1946 (15 U.S.C. 1051(a)) is*  
 11 *amended to read as follows:*

12 *“SECTION 1. (a)(1) The owner of a trademark used in*  
 13 *commerce may request registration of its trademark on the*  
 14 *principal register hereby established by paying the pre-*  
 15 *scribed fee and filing in the Patent and Trademark Office*  
 16 *an application and a verified statement, in such form as*  
 17 *may be prescribed by the Commissioner, and such number*  
 18 *of specimens or facsimiles of the mark as used as may be*  
 19 *required by the Commissioner.*

20 *“(2) The application shall include specification of the*  
 21 *applicant’s domicile and citizenship, the date of the appli-*  
 22 *cant’s first use of the mark, the date of the applicant’s first*  
 23 *use of the mark in commerce, the goods in connection with*  
 24 *which the mark is used, and a drawing of the mark.*

25 *“(3) The statement shall be verified by the applicant*  
 26 *and specify that—*

1           “(A) the person making the verification believes  
2           that he or she, or the juristic person in whose behalf  
3           he or she makes the verification, to be the owner of  
4           the mark sought to be registered;

5           “(B) to the best of the verifier’s knowledge and  
6           belief, the facts recited in the application are accu-  
7           rate;

8           “(C) the mark is in use in commerce; and

9           “(D) to the best of the verifier’s knowledge and  
10          belief, no other person has the right to use such mark  
11          in commerce either in the identical form thereof or in  
12          such near resemblance thereto as to be likely, when  
13          used on or in connection with the goods of such other  
14          person, to cause confusion, or to cause mistake, or to  
15          deceive, except that, in the case of every application  
16          claiming concurrent use, the applicant shall—

17                 “(i) state exceptions to the claim of exclu-  
18                 sive use; and

19                 “(ii) shall specify, to the extent of the verifi-  
20                 er’s knowledge—

21                         “(I) any concurrent use by others;

22                         “(II) the goods on or in connection  
23                         with which and the areas in which each  
24                         concurrent use exists;

25                         “(III) the periods of each use; and

1                   “(IV) the goods and area for which the  
2                   applicant desires registration.

3           “(4) The applicant shall comply with such rules or reg-  
4           ulations as may be prescribed by the Commissioner. The  
5           Commissioner shall promulgate rules prescribing the re-  
6           quirements for the application and for obtaining a filing  
7           date herein.”.

8           (b) *APPLICATION FOR BONA FIDE INTENTION TO USE*  
9           *TRADEMARK*.—Subsection (b) of section 1 of the Trademark  
10          Act of 1946 (15 U.S.C. 1051(b)) is amended to read as fol-  
11          lows:

12          “(b)(1) A person who has a bona fide intention, under  
13          circumstances showing the good faith of such person, to use  
14          a trademark in commerce may request registration of its  
15          trademark on the principal register hereby established by  
16          paying the prescribed fee and filing in the Patent and  
17          Trademark Office an application and a verified statement,  
18          in such form as may be prescribed by the Commissioner.

19          “(2) The application shall include specification of the  
20          applicant’s domicile and citizenship, the goods in connec-  
21          tion with which the applicant has a bona fide intention  
22          to use the mark, and a drawing of the mark.

23          “(3) The statement shall be verified by the applicant  
24          and specify—

1           “(A) that the person making the verification be-  
2           lieves that he or she, or the juristic person in whose  
3           behalf he or she makes the verification, to be entitled  
4           to use the mark in commerce;

5           “(B) the applicant’s bona fide intention to use  
6           the mark in commerce;

7           “(C) that, to the best of the verifier’s knowledge  
8           and belief, the facts recited in the application are ac-  
9           curate; and

10          “(D) that, to the best of the verifier’s knowledge  
11          and belief, no other person has the right to use such  
12          mark in commerce either in the identical form thereof  
13          or in such near resemblance thereto as to be likely,  
14          when used on or in connection with the goods of such  
15          other person, to cause confusion, or to cause mistake,  
16          or to deceive.

17          Except for applications filed pursuant to section 44, no  
18          mark shall be registered until the applicant has met the  
19          requirements of subsections (c) and (d) of this section.

20          “(4) The applicant shall comply with such rules or reg-  
21          ulations as may be prescribed by the Commissioner. The  
22          Commissioner shall promulgate rules prescribing the re-  
23          quirements for the application and for obtaining a filing  
24          date herein.”.

1       (c) *CONSEQUENCE OF DELAYS.*—Paragraph (4) of sec-  
 2       tion 1(d) of the Trademark Act of 1946 (15 U.S.C.  
 3       1051(d)(4)) is amended to read as follows:

4       “(4) The failure to timely file a verified statement of  
 5       use under paragraph (1) or an extension request under  
 6       paragraph (2) shall result in abandonment of the applica-  
 7       tion, unless it can be shown to the satisfaction of the Com-  
 8       missioner that the delay in responding was unintentional,  
 9       in which case the time for filing may be extended, but for  
 10      a period not to exceed the period specified in paragraphs  
 11      (1) and (2) for filing a statement of use.”.

12      **SEC. 4. REVIVAL OF ABANDONED APPLICATION.**

13      Section 12(b) of the Trademark Act of 1946 (15 U.S.C.  
 14      1062(b)) is amended in the last sentence by striking “un-  
 15      avoidable” and by inserting “unintentional”.

16      **SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AF-**  
 17                                      **FIDAVIT OF CONTINUED USE; NOTICE OF**  
 18                                      **COMMISSIONER’S ACTION.**

19      Section 8 of the Trademark Act of 1946 (15 U.S.C.  
 20      1058) is amended to read as follows:

21                                      “DURATION

22      “SEC. 8. (a) Each registration shall remain in force  
 23      for 10 years, except that the registration of any mark shall  
 24      be canceled by the Commissioner for failure to comply with  
 25      the provisions of subsection (b) of this section, upon the ex-  
 26      piration of the following time periods, as applicable:

1           “(1) For registrations issued pursuant to the  
2           provisions of this Act, at the end of 6 years following  
3           the date of registration.

4           “(2) For registrations published under the provi-  
5           sions of section 12(c), at the end of 6 years following  
6           the date of publication under such section.

7           “(3) For all registrations, at the end of each suc-  
8           cessive 10-year period following the date of registra-  
9           tion.

10          “(b) During the 1-year period immediately preceding  
11          the end of the applicable time period set forth in subsection  
12          (a), the owner of the registration shall pay the prescribed  
13          fee and file in the Patent and Trademark Office—

14               “(1) an affidavit setting forth those goods or  
15               services recited in the registration on or in connection  
16               with which the mark is in use in commerce and such  
17               number of specimens or facsimiles showing current  
18               use of the mark as may be required by the Commis-  
19               sioner; or

20               “(2) an affidavit setting forth those goods or  
21               services recited in the registration on or in connection  
22               with which the mark is not in use in commerce and  
23               showing that any such nonuse is due to special cir-  
24               cumstances which excuse such nonuse and is not due  
25               to any intention to abandon the mark.

1       “(c) The owner of the registration may make the sub-  
2 missions required by this section, or correct any deficiency  
3 in a timely filed submission, within a grace period of 6  
4 months after the end of the applicable time period set forth  
5 in subsection (a). Such submission must be accompanied  
6 by a surcharge prescribed therefor. If any submission re-  
7 quired by this section filed during the grace period is defi-  
8 cient, the deficiency may be corrected within the time pre-  
9 scribed after notification of the deficiency. Such submission  
10 must be accompanied by a surcharge prescribed therefor.

11       “(d) Special notice of the requirement for affidavits  
12 under this section shall be attached to each certificate of  
13 registration and notice of publication under section 12(c).

14       “(e) The Commissioner shall notify any owner who  
15 files 1 of the affidavits required by this section of the Com-  
16 missioner’s acceptance or refusal thereof and, in the case  
17 of a refusal, the reasons therefor.

18       “(f) If the registrant is not domiciled in the United  
19 States, the registrant shall designate by a written document  
20 filed in the Patent and Trademark Office the name and  
21 address of some person resident in the United States on  
22 whom may be served notices or process in proceedings af-  
23 fecting the mark. Such notices or process may be served  
24 upon the person so designated by leaving with that person  
25 or mailing to that person a copy thereof at the address spec-

1 *ified in the last designation so filed. If the person so des-*  
 2 *ignated cannot be found at the address given in the last*  
 3 *designation, such notice or process may be served upon the*  
 4 *Commissioner.”.*

5 **SEC. 6. RENEWAL OF REGISTRATION.**

6 *Section 9 of the Trademark Act of 1946 (15 U.S.C.*  
 7 *1059) is amended to read as follows:*

8 *“RENEWAL OF REGISTRATION*

9 *“SEC. 9. (a) Subject to the provisions of section 8, each*  
 10 *registration may be renewed for periods of 10 years at the*  
 11 *end of each successive 10-year period following the date of*  
 12 *registration upon payment of the prescribed fee and the fil-*  
 13 *ing of a written application, in such form as may be pre-*  
 14 *scribed by the Commissioner. Such application may be*  
 15 *made at any time within 1 year before the end of each suc-*  
 16 *cessive 10-year period for which the registration was issued*  
 17 *or renewed, or it may be made within a grace period of*  
 18 *6 months after the end of each successive 10-year period,*  
 19 *upon payment of a fee and surcharge prescribed therefor.*  
 20 *If any application filed during the grace period is deficient,*  
 21 *the deficiency may be corrected within the time prescribed*  
 22 *after notification of the deficiency, upon payment of a sur-*  
 23 *charge prescribed therefor.*

24 *“(b) If the Commissioner refuses to renew the registra-*  
 25 *tion, the Commissioner shall notify the registrant of the*  
 26 *Commissioner’s refusal and the reasons therefor.*

14        *Section 10 of the Trademark Act of 1946 (15 U.S.C.*  
15 *1060) is amended to read as follows:*

17       “SEC. 10. (a) A registered mark or a mark for which  
18 an application to register has been filed shall be assignable  
19 with the good will of the business in which the mark is used,  
20 or with that part of the good will of the business connected  
21 with the use of and symbolized by the mark. Notwithstand-  
22 ing the preceding sentence, no application to register a  
23 mark under section 1(b) shall be assignable prior to the fil-  
24 ing of an amendment under section 1(c) to bring the appli-  
25 cation into conformity with section 1(a) or the filing of the  
26 verified statement of use under section 1(d), except for an

1 assignment to a successor to the business of the applicant,  
2 or portion thereof, to which the mark pertains, if that busi-  
3 ness is ongoing and existing. In any assignment authorized  
4 by this section, it shall not be necessary to include the good  
5 will of the business connected with the use of and symbolized  
6 by any other mark used in the business or by the name  
7 or style under which the business is conducted. Assignments  
8 shall be by instruments in writing duly executed. Acknowl-  
9 edgment shall be prima facie evidence of the execution of  
10 an assignment, and when the prescribed information re-  
11 porting the assignment is recorded in the Patent and Trade-  
12 mark Office, the record shall be prima facie evidence of exe-  
13 cution. An assignment shall be void against any subsequent  
14 purchaser for valuable consideration without notice, unless  
15 the prescribed information reporting the assignment is re-  
16 corded in the Patent and Trademark Office within 3  
17 months after the date of the subsequent purchase or prior  
18 to the subsequent purchase. The Patent and Trademark Of-  
19 fice shall maintain a record of information on assignments,  
20 in such form as may be prescribed by the Commissioner.

21 “(b) An assignee not domiciled in the United States  
22 shall designate by a written document filed in the Patent  
23 and Trademark Office the name and address of some person  
24 resident in the United States on whom may be served no-  
25 tices or process in proceedings affecting the mark. Such no-

1 *tices or process may be served upon the person so designated*  
 2 *by leaving with that person or mailing to that person a*  
 3 *copy thereof at the address specified in the last designation*  
 4 *so filed. If the person so designated cannot be found at the*  
 5 *address given in the last designation, such notice or process*  
 6 *may be served upon the Commissioner.”.*

7 **SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN**  
 8 **REGISTRATION.**

9 *Section 44 of the Trademark Act of 1946 (15 U.S.C.*  
 10 *1126) is amended—*

11 *(1) in subsection (d)—*

12 *(A) by striking “23, or 44(e) of this Act”*  
 13 *and inserting “or 23 of this Act or under sub-*  
 14 *section (e) of this section”; and*

15 *(B) in paragraphs (3) and (4), by striking*  
 16 *“this subsection (d)” and inserting “this sub-*  
 17 *section”; and*

18 *(2) in subsection (e), by striking the second sen-*  
 19 *tence and inserting the following: “Such applicant*  
 20 *shall submit, within such time period as may be pre-*  
 21 *scribed by the Commissioner, a certification or a cer-*  
 22 *tified copy of the registration in the country of origin*  
 23 *of the applicant.”.*

1 **SEC. 9. MISCELLANEOUS AMENDMENTS.**

2       (a) *CANCELLATION OF FUNCTIONAL MARKS.*—Section  
3 14(3) of the Trademark Act of 1946 (15 U.S.C. 1064(3))  
4 is amended by inserting “or is functional,” before “or has  
5 been abandoned”.

6       (b) *INCONTESTABILITY DEFENSES.*—Section 33(b) of  
7 the Trademark Act of 1946 (15 U.S.C. 1115(b)) is amend-  
8 ed—

9               (1) by redesignating paragraph (8) as para-  
10 graph (9); and

11              (2) by inserting after paragraph (7) the follow-  
12 ing:

13              “(8) *That the mark is functional; or*”.

14 **SEC. 10. TRANSITION PROVISIONS.**

15       (a) *REGISTRATIONS IN 20-YEAR TERM.*—The provi-  
16 sions of section 8(a) of the Trademark Act of 1946, as  
17 amended by section 5 of this Act, shall apply to a registra-  
18 tion for trademark issued or renewed for a 20-year term,  
19 and existing on the effective date of this Act, on and after  
20 the date that is 1 year before the date on which the 20-  
21 year term expires.

22       (b) *APPLICATIONS FOR REGISTRATION.*—This Act and  
23 the amendments made by this Act shall apply to any appli-  
24 cation for registration of a trademark pending on, or filed  
25 on or after, the effective date of this Act.

1       (c) *AFFIDAVITS.*—*The provisions of section 8(b) of the*  
2 *Trademark Act of 1946, as amended by section 5 of this*  
3 *Act, shall apply to the filing of an affidavit if the sixth*  
4 *anniversary of the registration, or publication under section*  
5 *12(c) of the Trademark Act of 1946, for which the affidavit*  
6 *is filed is on or after the effective date of this Act.*

7       (d) *RENEWAL APPLICATIONS.*—*The amendment made*  
8 *by section 6 shall apply to the filing of an application for*  
9 *renewal of a registration if the expiration date of the reg-*  
10 *istration for which the renewal application is filed is on*  
11 *or after the effective date of this Act.*

12 **SEC. 11. EFFECTIVE DATE.**

13       *This Act and the amendments made by this Act shall*  
14 *take effect—*

15               (1) *on the date that is 1 year after the date of*  
16 *the enactment of this Act, or*

17               (2) *upon the entry into force of the Trademark*  
18 *Law Treaty with respect to the United States,*

19 *whichever occurs first.*